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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/643,502

08/22/2000

MICHAEL KORUS

CM03704H-C01

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02/07/2005

MOTOROLA, INC.

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IL01/3RD

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EXAMINER

PHAM, BRENDA H

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,502

Applicant(s)

KORUS, MICHAEL

Examiner

Brenda Pham

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-27 have been examined.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11 and 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,144,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-16 of the instant application encompass the patented invention of claims 1-11 of the above patent.

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673), claim 1, lines 29-43 and lines 52-55.

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 2, lines 56-59.

Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 1, lines 43-51.

Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 3, lines 60-63.

Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 4, lines 63-67.

Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 5, lines 1-7.

Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 6, lines 8-13.

Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 7, lines 14-24 and 33-35.

Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 7, lines 24-32.

Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 8, lines 36-38.

Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 9, lines 39-41.

Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 10, lines 42-53 and lines 60-63.

Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 11, line 64-67 and 104.

Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (US 6,144,673) claim 10, lines 54-62.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 19-27 are rejected under 35 USC 102(b) as being anticipated by KREBS et al (US 5,548,631).

Claim 19, KREBS et al discloses a method comprising the step of: receiving, from a communication unit participating in an audio call with at least one other communication unit (**communication unit 1 initiates a dispatch call request, column 7, lines 67**), a request for data from a server; forwarding, to the server, the requested data; (**gateway sends call request data to the dispatch application processor, column 8, lines 5-9**); forwarding, to the communication unit, the requested data via a communication resource that is supporting the audio call (**column 8, lines 9-15**).

Claim 20, KREBS et al further teach forwarding, to the at least one other communication unit, the requested data via the communication resource that is supporting the audio call (forwarding the requested data to communication units via base stations, see figure 2).

Claim 21, KREBS et al teaches wherein the method is performed by a data gateway (see access control gateway 201 of figure 2).

Claim 22, KREBS et al further teaches wherein the request is sent on the communication resource supporting the audio call (see figure 2).

Claim 24, KREBS et al further teaches where the requests form an entire message (column 6, lines 18-21).

Claims 25-26, KREBS et al teach wherein the request comprises an identity of the server (set up message identity of the server 104 for point to point communication or set up message identity the server 106 for dispatch call service, see abstract).

Claim 27, KREBS et al further teaches wherein the request indicates group data broadcast of the requested data (dispatch communications allow for communications amongst a group of users, without a need to individually identify each group member before initiating the communication (column 1, lines 20-25)).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over KREBS et al (US 5,548,631).

Claim 23, as explained in the rejection statement of claim 19 (parent claim), KREBS et al discloses all the claim limitations recited in claim 19. Although KREBS does not teach wherein the request is at least part of message, it is well known in the art to implement a request that is part of message.

Therefore, it would have been obvious to those having ordinary skill in the art at the time of the invention was made to implement a request that is at least part of message in KREBS et al.

Allowable Subject Matter

8. Claims 17-18 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art made of record does not teach a subscriber unit comprising: a processing unit; and memory that stores programming instructions that, when read by the processing unit, causes the processing unit to function to: receive an input for a group data broadcast; generate a data service message that includes an identity of the

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subscriber unit, an identity of at least one targeted host, a request for data, and an indication of a group data broadcast; and provide the data service message to a data gateway.

Conclusion

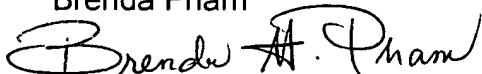
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (571) 272-3135. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

January 27, 2005

Brenda Pham

A handwritten signature in black ink that reads "Brenda A. Pham". The signature is written in a cursive style with a large, stylized "B" and "P".